

*32
Amend.*

internal conduit thereto, the first end plate further having a third internal conduit for each of the plurality of conductive rotor bars having the at least one first internal conduit for providing communication between the first coolant hole and the first end of the first internal conduit; and

a second end plate having a second bore in which the rotating shaft is sealingly fixed in proximity to the second cooling hole, the second end plate further having means for sealingly fixing the second end of each conductive rotor bar having the at least one first internal conduit thereto, the second end plate further having a fourth internal conduit for each of the plurality of conductive rotor bars having the at least one first internal conduit for providing communication between the second coolant hole and the second end of the first internal conduit;

wherein the circulation of coolant is established through the first, second, third, and fourth internal conduits for each conductive rotor bar having the at least one second internal conduit.--

REMARKS

This response is submitted in response to the Final Office Action mailed March 20, 2002, to request reconsideration of the rejection of claims 1, 2, 4 5, 7-10, 16, 17, and 20 as set forth therein. In the event the Examiner determines that the foregoing amendments do not place the case in condition for allowance, it is respectfully requested that the above amendments be entered to place the claims in better form for consideration on appeal.

Initially, Applicants would like to thank the Examiner for maintaining the indication that Claims 3, 6, 11-15, 18, 19, and 21 contain allowable subject matter. The

Examiner feels that claim 3 is allowable, with the remaining allowable claims depending from claim 3.

However, the Examiner also maintains the rejections of the remaining claims under 35 U.S.C. §§ 102(b) and 103(a). Specifically, the Examiner rejects claims 1, 9, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,488,532 to Endress et al. (hereinafter "Endress"). Additionally, the Examiner rejects claims 2, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 3,800,174 to Butterfield et al. (hereinafter "Butterfield"). Furthermore, the Examiner rejects claims 4, 5, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 4,728,840 to Newhouse (hereinafter "Newhouse"). Still further, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 3,629,628 to Rank et al. (hereinafter "Rank"). Lastly, the Examiner rejects claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view Rank and further in view of U.S. Patent No. 5,980,650 to Belt et al. (hereinafter "Belt").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103 (a) for at least the reasons set forth below.

In response to the previous Official Action, Applicants argued that Endress differs from that which is recited in independent claim 1 because it discloses separate tubular members (33, 60, and 71) that are arranged proximate to the conducting bars (35). In contrast, Applicants argued that claim 1 recites the conducting bar itself having an internal conduit.

In the Final Official Action, the Examiner argues that column 2, lines 55-60 of Endress discloses the tubular member (33) being "embedded" in the conducting bars (35).

Applicants respectfully submit that the meaning given to "embedded" by the Examiner is inconsistent with what is shown and taught in the Figures corresponding to column 2, lines 55-60. Applicants respectfully submit that the Examiner cannot give his or her own meaning to what is taught by a reference. A reference teaches that which would be understood by those of ordinary skill at the time of the invention.

Nowhere in Endress is a configuration shown where the tubular member is embedded within the confines of the rotor bar. Therefore, such an interpretation cannot be given to the term "embedded." "By"embedding" Endress refers to the proximate attachment of the tubular member to the rotor bar. No other meaning is contemplated or suggested by Endress. Endress neither shows a configuration with the tubular member embedded within the confines of the rotor bar nor discusses such as an alternative embodiment. Endress merely teaches the proximate attachment of a tubular member to the rotor bars.

Claim 1 has been amended to clarify this distinction over what is taught by Endress. Specifically, claim 1, as amended, recites that the internal conduit is integrally formed in at least one of the rotor bars. The amendment to claim 1 distinguishes from Endress in which a separate tubular member is proximately attached to a periphery of the rotor bar. Endress neither shows a tubular member having an internal conduit formed integrally within the rotor bar nor an internal conduit formed in the rotor bar itself, both of which are intended to be covered by claim 1, as amended. The amendment to claim 1 is fully supported in the original disclosure, particularly in the Drawings at Figures 3a and 3b and the accompanying text.

With regard to the rejection of claims 1, 9, and 20, under 35 U.S.C. § 102(b), a rotating machine having a plurality of conductive rotor bars, at least one of which having at

least one internal conduit integrally formed therein, as claimed in amended independent claim 1, is nowhere disclosed in Endress. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by Endress. Accordingly, independent claim 1 patentably distinguishes over Endress and is allowable. Claims 9 and 20 being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 9, and 20 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 2, 4, 5, 7, 8, 10, 16, and 17 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 2, 4, 5, 7, 8, 10, 16, and 17 are allowable therewith because they depend from an allowable base claim.

In other words, independent claim 1 is not rendered obvious by the cited references because neither the Endress patent, nor the Butterfield patent, nor the Newhouse patent, nor the rank patent, nor the Belt patent, whether taken alone or in combination, teach or suggest a rotating machine having a plurality of conductive rotor bars, at least one of which having at least one internal conduit integrally formed therein. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2, 4, 5, 7, 8, 10, 16, and 17, being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 2, 4, 5, 7, 8, 10, 16, and 17 under 35 U.S.C. § 103(a).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

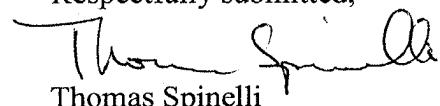
Furthermore, Applicants also argued in the previous response that claims 9, and 10 patentably distinguish over the cited references independently of their base claims because the conducting bars of Endress are shown as being uniform in cross-section (rectangular) and therefore could not show the features recited in claim 9. The Examiner responds by arguing that Figure 2 shows a conductive bar with an area of increased cross-section and that Figure 6 shows the internal conduit being cylindrical. Applicants respectfully disagree with the Examiners arguments. Firstly, the cross-section of the conductive bar in Figure 2 does not have an area of increased cross-section but merely an offset portion that does not increase its cross-sectional area. Secondly, Endress does not disclose a single configuration that has these two features. Rather, the Examiner cites Figure 2 for showing the increased cross-section and Figure 6 for showing the cylindrical internal conduit. Endress does not disclose or suggest that these features be combined in a single configuration. Therefore, Applicants respectfully submit that the Examiner's arguments with regard to claim 9 are improper. Therefore, Applicants again respectfully submit that claims 9 and 10 patentably distinguish over the cited references and are allowable.

Lastly, independent claim 27 has been added which merges the features of original claims 1 and 3 (and intervening claim 2). Claim 3 has been indicated as being allowable by the Examiner. Therefore, Applicants respectfully submit that new claim 27 patentably distinguishes over the prior art and is allowable.

Attached hereto is a marked-up version of the changes made to the application by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

The above amendments and remarks establish the patentable nature of all the claims currently in this case. Issuance of a Notice of Allowance and passage to issue of these claims are therefore respectfully solicited. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli

Registration No. 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

TS/cm

Encl. (Version with Markings to Show Changes Made)



VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

New claim 27 has been added and claim 1 has been amended as follows:

1. (Twice Amended) A rotating machine comprising:
 - a rotating shaft;
 - a plurality of conductive rotor bars spaced from the rotating shaft and fixed thereto through at least one intermediate member, at least one of the plurality of conductive rotor bars having at least one first internal conduit integrally formed therein; and
 - circulation means for establishing a coolant circulation through the first internal conduit.

**COPY OF PAPERS
ORIGINALLY FILED**